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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Yasushi Kasajima

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EXAMINER

GRAYSAY, TAMARA L

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/863,613	KASAJIMA ET AL.	
	Examiner	Art Unit	
	Tamara L. Graysay	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,7-11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,7-11 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary Matters

1. The examiner respectfully apologizes for the inadvertent typographical error in paragraph 14 of the previous Office action. Mikurak (US-6606744) is listed on the attached Notice of References Cited, form PTO-892.

Claim Objections

2. Claims 1, 8, 9 and 11 are objected to because of the following informalities:
 - a. Claim 1: The term “said monitoring information” appears to have been left in the claim inadvertently. The term lacks antecedent basis because the information has been consistently referred to as attribute information throughout the claims.
 - b. Claim 8: At the last line “said emergency calling signal” has been treated as emergency signal as recited at line 5 of the claim.
 - c. Claim 9: At the last line, “use actual result data” should be use actual result information as recited at line 4 of the claim.
 - d. Claim 11: line 2, “dwelling management services” should be dwelling management server as recited at line 5 of claim 4.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8/4, 8/7, 9/4, 9/7, 11/4, 11/7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 8/4 and 8/7/4: The phrase “such as” (claim 8, line 3) renders that claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

b. Claims 9/4 and 9/7/4: The term “with said customer’s use actual result database” (claim 9, line 2) is confusing as to whether the database is part of the center management server or whether they are separate elements because there is not antecedent basis for the term.

c. Claims 11/4 and 11/7/4: This previously independent claim has been amended to depend upon claims 4 or 7. As a result, numerous instances of indefiniteness have arisen.

A few examples follow:

i. The term “an indoor network” (line 6) is confusing insofar as the term is previously recited in claim 4, line 11 as “an indoor communication network.”

Clarification is required as to whether the terms are related to or distinguished from each other.

ii. Similarly, “a communication network” (line 12) is confusing insofar as the term is previously recited in claim 4, lines 2, and 7. Clarification is required.

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- iii. Further, “ a specific management server” (line 14) is confusing because there is only “a dwelling management server” recited in antecedent in claim 4, line 5. Clarification is required.
- iv. Further, “means for two-way communicating with a communication network” (line 12) is confusing because “a two-way communication network” is recited in antecedent at claim 4, line 8. Clarification is required.
- d. Claims 13/11/4 and 13/11/7/4: The term “said power information integration distribution panel” (line 6) is confusing because it lacks antecedent basis. The claim recites “a power information integration panel board” and “a power information distribution board” in antecedent. Clarification is required.
- e. Claims 13/11/4 and 13/11/7/4: The term “said information integration distribution board” (lines 8-9) is confusing for the same reason as paragraph (3)(d) above.
- f. Claims 13/11/4 and 13/11/7/4: The term “said the power information integration distribution panel board” (lines 10-11) is confusing for the same reason as paragraph (3)(d) above.
- g. Claims 13/11/4 and 13/11/7/4: The recitation of “or said office building” is confusing because claim 11 (line 7) is limited to living facilities and equipment including electric appliances “used in a dwelling house” not an office building.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Boylan (US-6799326).

Boylan discloses a method for offering specific customer information service to specific customers timely over a communication network according to the changes in daily living circumstances of the customers staying or living in a dwelling house or office building, the method comprising the steps of:

- monitoring at a dwelling management server (set top box 58) equipped in a house attribute information on living facilities and equipment (television equipment 54) used in said house;
- automatically sending immediately from the dwelling management server (set top box 58) said attribute information to a service server (television distribution facility 52) on the network when there occurs a change in attribute information (e.g., pay program purchase at 6:43-46) or at specific time intervals (poll set top boxes periodically for certain information, e.g., 5:66 – 6:3) when there is no change in attribute information, the dwelling management server (set top box 58) is in two-way communication with the living facilities and equipment (over communication paths 56, the information at the set

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top box 58 is transmitted therefrom to the television distribution facility 52 and the information at the television distribution facility 52 is transmitted therefrom to the set top box 58, see also 6:62-64); and

- storing and analyzing at the service server the attribute information (pay program purchase information is stored and analyzed at the television distribution facility in the form of account information, programs purchased, programs viewed, e.g., 6:1-3) and sending back a visual display after analyzing the attribute information in reply to the received attribute information (previously prepared video information, text, graphics stored in a database 57 are sent to the set top box in reply to the attribute information of the television equipment user, see for example, 5:38-59).

Regarding claim 4, Boylan discloses a system of offering customer information service to specific customers timely over a network according to changes in daily living circumstances of the customers staying or living in office buildings or dwelling houses, the system comprising:

- a dwelling management server in the dwelling house for monitoring attribute information on living facilities and equipment used in the dwelling house or office building (a set top box 58 monitors pay program account information or information regarding programs that are purchased and viewed, see for example, 6:1-3).
- the dwelling management server connected to a communication network by a two-way communication network (over communication paths 56, the set top box sends attribute information in the form of pay program account information and receives information in the form of video information, text, graphics, see for example 5:38-59, see also 6:62-64);

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- a service server (television distribution facility 52) on the communication network for providing customer information service (advertisements from the advertisement database 57, for example) providing information to the customers;
- wherein the dwelling management service is connected to an indoor communication network (television equipment in the home) to which living facilities and equipment (television equipment 54) are connected,
- the dwelling management unit constantly monitors the attribute information and sends information to the service server immediately when a change occurs and at specific time intervals when there is no change in information (see 5:60-6:3 which describes the constant monitoring of the set top box and alternatively periodic polling by the television distribution facility)
- wherein the service server stores and analyzes the attribute information from the dwelling management server and sends back visual display information to the dwelling management server introduction information on product or service selected from information prepared in advance in reply to the attribute information (the television distribution facility 52 sends previously prepared advertisements that are stored in the advertisement database 57 on basis of the region, cable company, income, pay program selection, etc. see for example, 5:27-37, 6:1-3, 6:18-20).

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boylan (US-6799326 filed 07 July 1998).

Regarding claim 7, the structural limitation of a multi-functional terminal unit is met by the set top box 58 which is capable of displaying a request receiving screen insofar as the screen is a visual display that is implemented through the television equipment 54. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a device does (Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)). Thus, if a prior art structure is capable of performing the intended use as recited in the preamble, or elsewhere in a claim, then it meets the claim.

Regarding claims 8/4 and 8/7/4 Boylan includes a network and associated communication paths that are capable of sending signals across the network. The calling device in Boylan includes at least a portion of the communication paths 56 which are capable of sending signals. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function,

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because apparatus claims cover what a device is, not what a device does (Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)). Thus, if a prior art structure is capable of performing the intended use as recited in the preamble, or elsewhere in a claim, then it meets the claim. Further, the term “emergency” does not structurally define over Boylan. The claim associates the calling device with the living facilities and equipment, and in Boylan the communications paths are associated with the television equipment 57. The users’ management database includes addresses of the dwelling houses (for example 6:4-9, main facility 46 handles information distribution tasks, so the main facility 42 inherently includes addresses for the set top boxes 58 and the associated television equipment 54 that are serviced with the information distributed by the main facility 42)

Regarding claims 9/4 and 9/7/4 Boylan includes a center management server in the form of a fulfillment facility 68 which analyzes the use actual data (user’s order). The fulfillment facility 68 includes means for collecting use actual result information insofar as the fulfillment facility 68 receives an order transmitted from the television distribution facility 52 (see for example, 6:64-67),

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6. Claims 10/4 and 10/7/4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boylan (US-6799326) as applied to claims 9/4 and 9/7, respectively above, and further in view of Mikurak (US-6606744).

The Boylan advertisements, etc. represent a service provided to television equipment users. Boylan mentions various markets, such as regional, income, provider, or other distinguishing features that are used to determine which particular services or advertisements are communicated via the set top box to users of the television equipment. However, Boylan is silent as to the particular analysis that is used to determine which service feature or advertisement is provided to the various users.

Mikurak teaches means for collecting data and preparing trend reports (FIG. 20) for use in evaluating the level and quality of service in the service industry.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Boylan to include means for executing a program to automatically prepare a market trend report using the actual result database and sending the report to advertisers (product manufacturers on the network) in order for the advertisers to determine which advertisements are effective.

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Allowable Subject Matter

7. Claims 11/4, 11/7/4, 13/11/4, and 13/11/7/4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments with respect to claims 1, 4, 7-11 and 13 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).


Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (571) 272-6728. The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Susanna Diaz
Primary Examiner
Au 3623